

REMARKS

Status of Claims

The subject application was originally filed with 37 claims. Claims 1-37 were amended by a preliminary amendment. Claims 11-37 were previously withdrawn as directed to non-elected species. In the present amendment, Applicant has amended claims 1, 6, and 7, cancelled claims 8, 9, and 11-37, and added new claims 38-43. Thus, claims 1-7, 10, and 38-43 are currently pending.

Summary of the Office Action

In the Office Action dated December 22, 2009, the Office:

1. withdrew claims 11-37 as being drawn to a nonelected species;
2. requested correction of the claim identifiers in the claim listing;
3. objected to the drawings for failing to show features specified in the claims;
4. rejected claim 6 under 35 U.S.C. § 112, second paragraph for failing to point out and distinctly claim the subject matter which applicant regards as the invention;
5. rejected claims 1-7 and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,368,316 issued to W.E. Crowder ("Crowder"); and
6. rejected claims 8-9 under 35 U.S.C. § 103(a) as being unpatentable over Crowder.

Election/Restriction

The Office noted that the claim listing of October 15, 2009 did not include current status identifiers. The status identifiers in the present amendment have been updated to correctly reflect the current status.

Objections to the Drawings

The Office objected to the drawings for failing to show the “strengthening formation” of claim 5. Applicant respectfully traverses this objection. One example of a strengthening formation is shown in Figures 1 and 3 as side flange portions 24. The specification explains that “the chamfered side flange portions 24 of the blank 10 form a base for the building block that provides additional strength.” (P. 15, lines 2–5.) Accordingly, the requirements of 37 C.F.R. § 1.83(a) have been met with respect to claim 5.

Applicant further notes that claim 5 is not intended to be limited to a preferred embodiment, but is instead entitled to a broad construction, with a scope commensurate with the specification. While the strengthening formation shown in Figures 1 and 3 meet the requirements of 37 C.F.R. § 1.83(a), claim 5 covers other embodiments, including, without limitation, those described on p. 4, lines 5–9.

The Office also objected to the drawings for failing to show the “reinforcing means” of claim 6. Applicant respectfully traverses this objection. Claim 6, as amended, now recites a “reinforcing member” instead of “reinforcing means.” Support for this amendment may be found throughout the specification, specifically in Figure 7, and on p. 4, lines 7–9, p. 17, lines 1–18, p. 39, lines 1–8, and p. 40, lines 4–16. One example of a reinforcing member is shown in Figure 7 as cable ties 510. These ties are described on p. 17, lines 1–18. Accordingly, the requirements of 37 C.F.R. § 1.83(a) have been met with respect to claim 6.

Applicant further notes that claim 6 is not intended to be limited to a preferred embodiment, but is instead entitled to a broad construction, with a scope commensurate with the specification. While the reinforcing members shown in Figure 6 meet the requirements of 37 C.F.R. § 1.83(a), claim 6 covers other embodiments, including, without limitation, those described on p. 4, lines 7–9, p. 39, lines 1–8, and p. 40, lines 4–16.

Rejections Under 35 U.S.C. § 112, second paragraph

The Office rejected claim 6 under 35 U.S.C. § 112, ¶ 2 because of the term “a third aperture.” Claim 6 has been amended by deleting this limitation, and now recites “an additional aperture.” Accordingly, this rejection under 35 U.S.C. § 112, ¶ 2 is believed to have been obviated and Applicant respectfully requests that it be withdrawn.

The Office also asserted that the term “reinforcing means” is a means-plus-function limitation that invokes 35 U.S.C. § 112, ¶ 6, and that the corresponding structure is not sufficiently disclosed in the written description. Applicant respectfully traverses this rejection. Claim 6 has been amended to recite a “reinforcing member,” and 35 U.S.C. § 112, ¶ 6 is not applicable. This amendment is fully supported by the specification, specifically in Figure 7, and on p. 4, lines 7–9, p. 17, lines 1–18, p. 39, lines 1–8, and p. 40, lines 4–16. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 102(b)

The Office rejected claims 1–7 and 10 under 35 U.S.C. § 102(b) as being anticipated by Crowder. Applicant respectfully traverses this rejection.

Claim 1, as amended, recites: “the blank is formed from sheet metal.” Support for this amendment may be found in original claim 8 and throughout the specification, such as at p. 4, lines 14–15 and p. 8, lines 5–7. No new matter has been added. In addressing claim 8, the Office conceded that Crowder does not disclose a blank formed of sheet metal. Accordingly, because this element has been incorporated into claim 1, Crowder fails to disclose each and every element of claim 1, and the anticipation rejection under 35 U.S.C. § 102(b) should be withdrawn.

With respect to the recitation of sheet metal in claim 8, the Office asserted that it would have been obvious to form the blank of Crowder out of sheet metal. Applicant respectfully

traverses this assertion. While it may be obvious to select a known material on the basis of its *suitability for the intended use* as a matter of design choice, in this instance, forming the blank of Crowder from sheet metal would render it *unsuitable* for its intended use. Crowder discloses “[t]oy and decorative building blocks stamped from *cardboard-like material*.” (Col. 1, lines 10–11, *emphasis added*; *see also* col. 3, lines 14–15). Crowder further discloses that an object of the invention is to provide “means readily being disengageable to permit the *restoration of the block to [a] flat, unfolded position* for storage and the like” (col. 2, lines 21–23, *emphasis added*) and notes that the “elements may be *quickly restored to flat condition* and thus compactly stored in a suitable carton or box until the time for the next use thereof arrives” (col. 7, lines 38–41, *emphasis added*).

In other words, the purpose of Crowder was to provide a block that is readily assembled and *disassembled*. Forming the Crowder blocks from sheet metal, as suggested by the Office, would remove the ability of the Crowder blocks to be quickly and simply disassembled for storage, which is one of the specific requirements of Crowder. This is an improper modification—a “proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference.” MPEP § 2145 (*citing* MPEP § 2143.01.) Moreover, the skilled person would not consider forming the Crowder blocks from sheet metal, as this would be contrary to the specific disclosure of Crowder.

Therefore, because Crowder fails to teach or suggest each and every element of claim 1 as amended, Applicant asserts that claim 1 is not obvious in view of Crowder and respectfully requests that the claim be allowed. Further, claims 2–7 and 10 depend directly from claim 1, and incorporate each and every element therein. Therefore, Applicant asserts that these claims are allowable for at least the same reason described above.

Rejections Under 35 U.S.C. § 103(a)

The Office rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Crowder. Claims 8 and 9 have been cancelled and their rejections are now moot.

New Claims

As discussed above, Applicant has added new claims 38–43. Applicant submits that these new claims do not introduce new matter as they are fully supported by the specification and drawings of the subject application. Applicant further asserts that they are drawn to the elected Species I, Figures 1-7. Consideration of this new claims should not require an additional search. Applicant respectfully submits that new claims 38–43 are patentable in light of the prior art of record.

CONCLUSION

With the above election, the Application is now in condition for examination and allowance on the merits. Applicants appreciate the Examiner's attention to this matter. While no additional fees are believed necessary, the Commissioner is authorized to charge any needed fees or credit any overpayments to Deposit Account No. 02-2051 referencing Attorney Docket Number 28125-4.

Respectfully submitted,

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